

PATENT**D3239-00002****III. Remarks**

Claims 1-6, 8-14, 16-22, 24 and 26-34 are presently pending in the present application. Claim 26 has been amended.

Applicants are grateful to the Examiner for withdrawing the previous rejection of the claims based on Anderson and Redax.

A. Rejection of Claims 26 and 27 under 35 USC §101

The Action rejects Claims 26 and 27 as being directed to non-statutory subject matter. Claim 26 has been amended as suggested by the Examiner to recite a "computer implemented method" though it is suggested that this feature is inherent in the recital of a "PDF document." It is submitted, however, that Claims 26 and 27 were/are directed to statutory subject matter as creating a useful and tangible result (creating an output PDF file) both before and after amendment, in compliance with the Board of Patent Appeals and Interference's recent decision in In re Lundgren.

Reconsideration and withdrawal of this rejection of Claims 26 and 27 are respectfully requested.

B. Claims Rejection under 35 U.S.C. §103(a)**1. Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24 and 28-33**

The Action rejects Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24 and 28-33 as being obvious in view of U.S. Patent No. 5,581,682 to Anderson et al. (hereinafter "Anderson") in view of U.S. Patent No. 5,903,646 to Rackman. Reconsideration and withdrawal of the rejection of these claims are respectfully requested in view of the following arguments.

Each of the independent claims of the rejected set – Claims 1, 9, 17 and 26 – was previously amended to recite that the identified or designated content for redaction include at

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least one image. Claims 1, 9, 17 and 26 also recite that the one or more content objects comprise "one or more image occurrence objects." As explained in the present application, Applicants' present invention can be employed in the redaction of text from, for example, PDF documents and in the redaction of images (i.e., pictures) from these documents. (Specification, Pages 6-7). Different redaction methods are described for text redaction and for image redaction, with redacted text being replaced with exemption codes, hyphens or other material and image redaction being carried out on a pixel-by-pixel basis, with identified pixels being replaced rather than identified text. Comparison of annotation objects are made to content objects that are text occurrence objects and to content objects that are image occurrence objects to remove identified text and to remove identified images (or portions of images).

Using Claim 1 as exemplary of this group of rejected independent claims, the Examiner concedes that Anderson does not teach at least the step of "creating an electronic output file, said identified content not present in said output file, a redacted document being producible from said output file for display." Applicants have discussed Anderson in depth in prior responses, and a detailed discussion of Anderson is not warranted. Suffice it to say though, that the Examiner correctly makes this concession because Anderson clearly teaches an abstraction overlay methodology that does not remove the original content from the electronic version of the abstracted document. Rather, the technique of Anderson overlays areas when a redacted document is displayed. The Examiner then relies on Rackman for providing the missing step.

Rackman teaches an access control system for litigation document production. (Abstract). Rackman recognizes that litigation documents responsive to document requests are often produced to the requesting party in optical disk format (i.e., in electronic form). (Column 2, Lines 1-50) The producing party frequently redacts portions of documents placed on the optical disks, such as for privilege or confidentiality reasons. If a judge subsequently rules that the redaction was improper for any reason, the producing party then has to recreate the optical disks to include documents without the improper redaction.

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Recognizing this problem, Rackman developed a system where two versions of a document are both produced to the requesting party in electronic form. Unredacted documents are produced, but encrypted. If a judge, for example, rules that the redaction was improper, the producing party can simply provide the encryption key to the requesting party. Redacted documents are provided to the producing party without encryption so that they can be readily accessed. (See, e.g., Column 7, Lines 53-57)

Of particular importance is the description of Rackman regarding how redaction of documents occurs. "[I]f redaction is required, then in step 32 an image is created which is a redacted form of the original. The original image is retained along with the redaction. **Standard software can be used for this purpose.**" (Column 8, Line 66 – Column 8, Line 2). Applicants have reviewed the disclosure of Rackman, but can find no more detail than this on how the actual redaction process works. Rackman, therefore, provides no more with respect to redaction processes for electronic documents than does Anderson.

To be clear, Rackman provides no disclosure with respect to the form of the actual electronic output file corresponding to the redacted document or how the file is created, other than that standard software can be used. If anything, the Examiner should look to Anderson as evidence of these "standard software" techniques for redaction, meaning the combination of Rackman and Anderson would use image overlays and leave redacted content within the "electronic output file."

Simply, the combination would not remove content as claimed by Applicants. This removal of actual electronic content in the creation of the electronic output files is very important in, for example, redacting PDF files. An Adobe PDF file can have any number of images on a given page defined as image objects. These images can overlap one another and obscure one another. In the instance of these overlaps, the claimed process, which removes all identified content, redacts all of the image data that intersects with the area identified by the user as containing sensitive information, including any number of images that may be stacked one on

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top of the other, or that otherwise overlap one another. The product's ability to establish the coordinates of images relative to one another in a Cartesian space, to assess the intersection of these images with the area defined by the user as containing sensitive information, and to perform the pixel-by-pixel replacement, for example, of the relevant image data so as to expunge all traces of the original, is an important aspect to the claimed method and cannot be achieved by the cited combination of references.

Perhaps the Applicants have misinterpreted the Examiner's reliance on Rackman, and the Examiner has concluded that Rackman actually copies a physically redacted document and then stores it in electronic format, so that the redacted content does not exist in the electronic document. If this is the case, and Applicants do not read Rackman as such, then Rackman still does not teach one in the art familiar with Anderson how to create an electronic output file, said identified content not present in said output file, a redacted document being producible from said output file for display" where the content is identified in a document in electronic form and removed using the steps claimed by Applicant.

In summary, the combination of Anderson and Rackman, therefore, provides no more with respect to redaction techniques than does Anderson alone. It is submitted that the combination would simply provide a document redacted in the form taught by Anderson and thus, like Anderson, would not "creat[e] an electronic output file, said identified content not present in said output file, a redacted document being producible from said output file for display" as claimed by Applicants.

For at least these reasons, it is submitted that the combination of Anderson and Rackman does not teach each feature of independent Claims 1, 9, 17 and 26. Therefore, it is submitted that Claims 1, 9, 17 and 26 are allowable over the cited combination of references. Claims 2-4, 10-12, 18-20 and 27-34 depend from these claims and are, therefore, also allowable.

Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

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2. Claims 31-33

Claims 31-33 each recite that the removal comprises “replacing pixels corresponding to the identified content,” i.e., the content comprising at least one image. Applicants have clearly distinguished image content, for example pictures, from textual content, for example, text. In support of the rejection of these claims, the Examiner states “Rackman teaches redaction involving images and does mention pixels.” (emphasis added) The Examiner then concludes that “since modifications in an electronic document generally involve modifications of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification.”

First, by Applicants’ review, Rackman *mentions* “pixel” once in the description, at Column 3, Lines 12-16, in a discussion of rearranging “pixels representing the unredacted image” to accomplish the desired encryption, but not in connection with redaction.

Further, Applicants submit that the Examiner has not provided any support for the statement that “modifications in an electronic document generally involve modifications of its representative pixels . . .” Applicants submit that the combination of Anderson and Rackman, as discussed above, accomplishes visual modification using overlays as taught by Anderson, not a replacement of pixels corresponding to image content in the removed of content and creation of an electronic output file with the identified content not present as claimed.

Patent Office Rule 104(c)(2) (37 C.F.R. § 104(c)(2)) requires that “in rejecting claims for . . . obviousness, the examiner must cite the best references at his or her command” (emphasis added). However, in making the statement, quoted above, about what “modification in an electronic document generally involve” the Office failed to cite any prior art. Accordingly, it appears that the Examiner is relying upon facts within the Examiner’s knowledge, as provided by 37 C.F.R. § 104(c)(3). Applicants therefore respectfully request an Examiner’s affidavit, pursuant to 37 C.F.R. § 104(d)(2) containing the following information:

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- a. all facts within the personal knowledge of the Examiner regarding the "modifications in an electronic document generally involv[ing] modifications of its representative pixels" at the time of the invention in redacting electronic documents as set forth in the rejection of Claims 31-33; and
- b. all tests or experiments which the Examiner has directly witnessed or participated in involving the "modifications in an electronic document generally involv[ing] modifications of its representative pixels" in redacting electronic documents at the time of the invention as set forth in the rejection of Claims 31-33.

Without cited prior art or Examiner affidavit testimony, supporting the conclusory contentions stated in the Office Action regarding the rejection of Claims 31-33, Applicants are deprived of their right to know the relevant factual bases of this obviousness rejection. As expressly provided in Rule 104(d)(2), any affidavit submitted by the Examiner "shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." Applicants reserve the right to submit such controverting and/or explanatory testimony, upon receipt of the information requested above.

Reconsideration and withdrawal of the rejection of Claims 31-33 are respectfully requested for at least these reasons.

3. Independent Claims 5, 13 and 21; Dependent Claims 6, 8, 14, 16, 22 and 24

The Action rejects independent Claim 5 as being obvious from Anderson in view of Rackman.

Claim 5 is directed to a method for designating portions of a document comprising content including at least one image for redaction. A geographic region of a document is designated for redaction. The designating step includes manipulating a frame displayed on the documents where content having a geographical location within the frame is visible to the user during the manipulation step. The manipulable frame is shown, for example, as window 45 in

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FIG. 2 of Applicants' disclosure. It should be understood that the designating step is not a step of displaying the redacted documents, but rather a means of identifying areas for redaction.

It appears from a reading of the rejection that the Examiner is focusing on the actual annotated document of Anderson, as opposed to the actual method Anderson uses to designate areas for annotation/redaction. Indeed, the Examiner cites to Figures 3A-3B and 4 of Anderson, which show the display of annotated documents having annotation windows overlaid onto the document.

The portion of Anderson's disclosure upon which we must focus is how the system of Anderson enables the user to add the overlays, not the actual display. Anderson provides merely that the user can specify the characteristics and content of the annotation, including location, size and orientation, by a "command entry or a pull down menu." (Column 6, Lines 16-20). This is the only disclosure provided by Anderson regarding creation of the overlays. Rackman, discussed above, provides only that redaction can be done using standard software.

This dearth of disclosure clearly does not teach or suggest "wherein said step of designating [a geographic region of the document for redaction] comprises manipulating a frame displayed on the document, content having a geographical location within said frame being visible to the user during said step of manipulation, said content comprising at least one image" as claimed in Claim 5.

In summary, the "command entry and pull down menu" do not teach or suggest that a frame is displayed to a user, with content visible in the frame, to assist in designating content to be redacted. It is submitted, therefore, that Claim 5, and Claims 6 and 8, which depend from Claim 5, are allowable over the art of record. Reconsideration and withdrawal of the rejection are respectfully requested.

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Like Claim 5, Independent Claims 13 and 21 both recite the manipulation feature for designating a geographic region of a document for redaction. For at least the reasons set forth above in connection with Claim 5, therefore, it is submitted that Claims 13 and 21, and Claims 14 and 16 and 22 and 24, which depend from Claims 13 and 21, respectively, are also allowable. Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

4. Claims 3-4, 11-12, 19, 26-27 and 34

The Action rejects Claims 3-4, 11-12, 19, 26-27 and 34 as being obvious from the combination of Anderson and Rackman in further view of Redax.

Claims 3-4 depend from Claim 1 and are allowable for at least the reasons set for the above in connection therewith.

Claims 11-12 depend from Claim 9 and are allowable for at least the reasons set for the above in connection therewith.

Claim 19 depends from Claim 17 and is allowable for at least the reasons set for the above in connection therewith.

Independent Claims 26 recites the step of creating an output PDF file having said identified content removed therefrom, wherein a redacted document is producible from said output PDF file where the content includes at least one image and text. As set forth above in connection with Claim 1, the combination of Anderson and Rackman does not teach the claimed method of redacting content comprising at least one image. For at least this reason, it is submitted that Claim 26 and Claim 27, which depend therefrom, are allowable over the art of record.

Reconsideration and withdrawal of the rejection of these claims are respectfully requested.

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IV. Conclusion

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance at an early date, which action is earnestly solicited.

The Commissioner for Patents is hereby authorized to charge any additional fees or credit any excess payment that may be associated with this communication to deposit account 04-1679.

Respectfully submitted,

Dated: 11/15/05


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